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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,471	07/13/2001	Robert R. DeWitt	0412-P02404USO	8106

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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,471

Applicant(s)

DEWITT ET AL.

Examiner

Edward R. Cosimano

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
4a) Of the above claim(s) 19-28 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The drawings are objected to because
 - A) the following errors have been noted in the drawings:
 - (1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:
 - (a) reference number 105 as disclosed in the paragraph between page 36, line 6, and page 37, line 2, "From the labeler 95 ... conveyor 105 ... and applied label of the piece.";
- 2.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
- 2.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.
- 2.3 The proposed drawing correction filed July 27, 2003 has been approved.
3. The disclosure is objected to because of the following informalities:
 - A) applicant must update:
 - (1) the application data in the paragraph:
 - (a) between page 29, line 13 and page 30, line 4, "Although the computer ... U.S. Application No. 09/816,687 ... application No. 09/816,687 ... reader 80 and labeler 95."; and

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(b) between page 35, line 8, and page 36, line 4, "If the computer ... No. 09/816,687 ... piece cannot be determined."; with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 28 & 58 of fig. 5, note the use of motor 58 in fig. 6, (page 19, lines 11—15, "A reversible motor 58 ... motor 58 ... motor 58 ... back to the feeding station 20.";

In this regard, it is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) as can be seen in figs. 1-4 & 9 and from the context of the paragraph at page 9, lines 8-17, "As mentioned above, conveyor 22 ... conveyor motor 27 ... conveyor motor 22. More ... feed sensor 24 described above.", at line 7 of this paragraph as amended June 27, 2003 the reference to "conveyor motor 22" should be --conveyor motor 27--.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

5. Applicant's inclusion of non-elected machine/apparatus claims 20-25, into process/method claim 13/18 by dependency creates an improper hybrid claim and hence this combination of claimed subject matter is confusing. This confusion occurs, since it can not be

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determined into which one of the statutory classes of invention the combined claim is to be classified as, that is either:

- A) a process, or
- B) a machine, or
- C) a manufacture, or
- D) a composition of matter.

Note ex parte Lyell, 17 USPQ 2nd 1548 (Bd. Pat. App. & Inter. 1990) and MPEP § 2173.05(p).

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 1, 2, 6-8, 10, 11 & 13-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sansone et al (5,008,827) in view of Sansone et al (5,925,864) as evidenced and interpreted in view of Webster's Ninth New Collegiate Dictionary, Kolisch (2,689,082) and Uno et al (5,535,127).

6.1.1 In regard to claims 1, 2, 6-8, 10, 11 & 13-18, Sansone et al ('827) discloses a mail processing system that includes the following elements:

A) a conveyor system for transporting the items of mail through the mail processing system (note mail path 78);

B) a scale 88 for weight the item of mail as the mail is conveyed through the mail processing system;

C) a scanner 84, for scanning the preprinted information on an item of mail, that is address information, as the mail is conveyed through the mail processing system;

D) a labeler/printer 92, for applying information to the items of mail as the mail is conveyed through the mail processing system;

E) a processor 60 which controls the operation of the system and determines the correct amount of postage for the item of mail based on the destination address and weight as well as post office discount requirements; and

F) a postage meter 90 for applying the correct amount of postage to the item of mail as the mail is conveyed through the mail processing system.

6.1.2 In regard to the claimed use of labels, Sansone et al ('827) disclose printing the information on a label which is then applied to the item of mail, however, as clearly taught by Sansone et al ('864) the labeler/printer of the mail processing system may apply the information to the items of mail by printing the information either:

A) directly to the item of mail, or

B) directly on a label that is applied to the item of mail,

as the mail is conveyed through the mail processing system. Hence, from the teachings of Sansone et al ('864) the printing of the information by either method of:

A) directly to the item of mail, or

B) directly on a label that is applied to the item of mail,

is functionally equivalent to the other method of applying information to items of mail. Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Sansone et al ('827) could be modified to apply information to a label that will be applied to an item mail as taught by Sansone et al ('864). Further, this combination would be within the level of ordinary skill at the time of the invention, since one of ordinary skill at the time of the invention was made would have readily recognized that either method of applying information to an item of mail as taught by Sansone et al ('864) or the certification of Sansone et al ('827) as labeling because as defined in

Webster's Ninth New Collegiate Dictionary (Merriam-Webster Inc., Publishers Springfield, Massachusetts ©1986) the act of labeling includes "3 ... b: written or printed matter accompanying an article to furnish identification or other information".

6.1.3 In regard to using the scanned information and weight to determine the correct postage amount, it is noted that as taught by Kolisch ('082) in 1954 the amount of postage required for an item of mail is based on at least the weight and destination with respect to the origin of the item of mail. Hence, in view of the information required for determining the correct amount of postage as understood by one of ordinary skill at the time the invention was made as evidenced by Kolisch ('082), it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Sansone et al ('827) as modified by Sansone et al ('864) would consider both the weigh and destination of an item of mail relative to the origin of the mail when determining the correct amount of postage for the item of mail.

6.1.4 In regard to claims 3-5 & 12, Sansone et al ('827) does not describe in detail the operation of ocr device 84, however as taught by Uno et al ('127) in 1996, an ocr scanner would build an image of a moving object by combining a number of individual scans of the object to build an image of the object and then processes the image to identify the information contained in the image. Since the ocr device of Sansone et al ('827) as modified by Sansone et al ('864) is required to obtain and process an image of a moving item as does the image processing device of Uno et al ('127), it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Sansone et al ('827) as modified by Sansone et al ('864) use ocr device 84 to obtain an image of the item of mail and hence the address information as taught by Uno et al ('127).

6.1.5 In regard to the sorting function of claims 5-8, note that some of the processed mail is rejected and other items of processed mail are sent to the Postal system.

6.2 Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sansone et al (5,008,827) in view of Sansone et al (5,925,864) as evidenced and interpreted in view of Webster's Ninth New Collegiate Dictionary, Kolosch (2,689,082) and Uno et al (5,535,127) as applied above to claims 1-8 & 10-18 and further in view of York et al (5,926,392).

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6.2.1 In regard to claim 9, the combination of Sansone et al ('827) as modified by Sansone et al ('864) does not disclose re-orientating the item of mail during the processing, however, York et al ('392) discloses that in mail processing systems it is sometimes necessary to re-orientate item of mail so that the item of mail may be processed by the mail processing system. Hence, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of either Connell et al ('228 or '124) or Sansone et al ('827) or Metelits et al ('306) or Uno et al ('127) or Gil et al ('514) could be modified to include the use of an re-orientation means so that the items of mail may be properly processed as taught by York et al ('392).

7. Response to applicant's arguments.

7.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

7.2 As per the objections to the drawings and disclosure, since applicant either failed to address or correct the noted defects, these objection have been maintained.

7.3 As per the 35 U.S.C. § 103 rejection, since:

A) since the claims fail to recite a limitation that would limit the claimed invention to a particular aspect of the mail delivery and processing system, the claimed invention may be at any point of the mail delivery and processing system.

Hence, applicant's argument's are non persuasive.

8. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

9.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

9.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

04/03/04



Edward R. Cosimano
Primary Examiner A.U. 3629